APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,160	02/09/1999	RICHARD W. CHESTON	RP9-98-096	8471

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EXAMINER
TESFAMARIAM, MUSSIE

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary

Application No.	Applicant(s)
09/248,160	Richard W. Cheston
Examiner	Art Unit
Mussie Tesfamariam	3622

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ___3___ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jun 27, 2002*

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-21* _____ is/are pending in the application.

    4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-21* _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some* c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

DETAILED ACTION

1.Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection, Fink et al, 5953533.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3.   Claim 1- 3, 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of Thomas, 4685055, Harding, 5794052, Fink etal, 5953533.

As per claim 1, Christer disclose in a personal computer system initially loaded with software including selected See fig 1, Pages 4-6. However, he fails to disclose in non-selected software in unusable form, Harding, 5794052 disclose in non-selected software in unusable form. See col 3, lines 32-37, col 8, lines 3-9. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will load non-selected software. This is because it would improve Christer's system to have a software in unusable form. He also disclose in the selected software later converted and loaded in usable form. See fig 1, PP 4-6. He discloses in selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in paying royalties on only the selected software. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment. Fink et al, 5953533 discloses in selected programs stored in the storage device in usable form aft er conversion from unusable form selected programs having been converted by the processor from unusable form and stored in usable form, see fig 1, col 3, lines 53-67 -- col 4, lines 1-33, col 7, lines 21-31, with non-selected programs not being converted into usable form. See col 4, lines 1-5. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention

was made to modify the system of Christer such that it will load non-selected software. This is because it would improve Christer's system to have a software in unusable form.

As per claim 2, Christer disclose in a personal computer system initially loaded with software including selected See fig 1, Pages 4-6. However, he fails to disclose in a software which erases non-selected software from the personal computer. Harding discloses in a software which erases non-selected software from the personal computer. See col 3, lines 32-37, col 8, lines 3-9. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will erase non-selected software. This is because it would improve Christer's system to remove unnecessary software so it can have enough and fast memory to run or execute programs in a PC.

As per claim 3, Christer disclose in a personal computer includes a software module for converting the selected software from an unusable form into an usable form in response to the selection and the list of selected software. See fig 1, Pages 4-6. However, he fails specifically to disclose in paying royalties on only the selected software. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment.

As per claim 5, Christer disclose in a personal computer includes a software module for converting the selected software from a compressed form to uncompressed form. See Page 4.

As per claim 6, Christer disclose in a software module for selection of the selected software including to input the user's function and to select software for addition or deletion based on the software associated with the user's function. See PP 1, 5-6.

4.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of Thomas, 4685055 and Harding, 5794052 as applied to claim 1 above, and further in view of Halter et al, 5319705.

As per claim 4, Christer disclose in a personal computer includes a software module for converting the selected software from the selected software. See fig 1, Pages 4-6. However, he fails specifically to disclose in a software which is converted from encrypted to unencrypted form. Halter et al disclose in a software which is converted from encrypted to unencrypted form. See the abstract, fig 12, fig 14, col 28, lines 19-26. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will be converted from encrypted to unencrypted form. This is because it would improve Christer's system to read the decoded software.

5.   Claim 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of Harding, 5794052, Thomas, 4685055, Fink et al, 5953533 and www.patents. ibm.com.

As per claim 7, Christer disclose in a personal computer system initially loaded with software including selected See fig 1, Pages 4-6. However, he fails to disclose in non-selected software in

unusable form, Harding, 5794052 disclose in non-selected software in unusable form. See col 3, lines 32-37, col 8, lines 3-9. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will load non-selected software. He also disclose in the selected software later converted and loaded in usable form. See fig 1, PP 4-6. He discloses in selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in paying royalties on only the selected software. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment. He also fails to disclose in selecting the software programs which are needed for that personal computer. www.patents. ibm.com disclose selecting the software programs which are needed for that personal computer. See Page 1. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select the software programs which are needed for that personal computer. He also fails to disclose in paying royalties on only the selected software. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of

Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment. Fink et al, 5953533 discloses in selected programs stored in the storage device in usable form aft er conversion from unusable form selected programs having been converted by the processor from unusable form and stored in usable form, see fig 1, col 3, lines 53-67 -- col 4, lines 1-33, col 7, lines 21-31, with non-selected programs not being converted into usable form. See col 4, lines 1-5. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will load non-selected software. This is because it would improve Christer's system to have a software in unusable form.

As per claim 8, Christer disclose in a personal computer system initially loaded with software including selected See fig 1, Pages 4-6. However, he fails to disclose in a software which erases non-selected software from the personal computer. Harding discloses in a software which erases non-selected software from the personal computer. See col 3, lines 32-37, col 8, lines 3-9. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will erase non-selected software. This is because it would improve Christer's system to remove unnecessary software so it can have enough and fast memory to run or execute programs in a PC.

As per claim 9, Christer disclose in a personal computer system initially loaded with software including selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion

˙from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form. He also disclose in storing the converted software programs in usable form into the storage of the personal computer. See fig 1, Pages 4-6. However, he fails specifically to disclose selecting the software programs which are needed for that personal computer. www.patents. ibm.com disclose selecting the software programs which are needed for that personal computer. See Page 1. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select the software programs which are needed for that personal computer. This is because it would improve Christer's system to differentiate how to select the necessary software from unnecessary software.

As per claim 10, Christer disclose in a personal computer system initially loaded with software including selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form. He also disclose in storing the converted software programs in usable form into the storage of the personal computer. See fig 1, Pages 4-6. However, he fails specifically to disclose selecting the software programs for a personal computer includes the step of identifying the job function of the user. www.patents. ibm.com disclose in selecting the software programs for a personal computer includes the step of identifying the job function of the user. Therefore, it would have been obvious to a person of

ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select the software programs which are needed for that personal computer in the step of identifying the job function of the user. This is because it would improve Christer's system to identify the user's job function.

As per claim 11, Christer disclose in a software module for selection of the selected software including to input the user's function and to select software for addition or deletion based on the software associated with the user's function. See PP 1, 5-6.

6.   Claim 12, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of WWW.patents.ibm.com.

As per claim 12, Christer disclose in a personal computer system initially loaded with software including selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in a module associated with the processor and responsive to the selecting of certain programs to make the selected programs active and usable. www.patents.ibm.com disclose in a module associated with the processor and responsive to the selecting of certain programs to make the selected programs active and usable. See Page 1.Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made

to modify the system of Christer such that it will select certain programs. This is because it would improve Christer's system to eliminate unnecessary programs from being selected.

As per claim 14, Christer disclose in a personal computer system initially loaded with software including selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form. He also disclose in storing the converted software programs in usable form into the storage of the personal computer. See fig 1, Pages 4-6. However, he fails specifically to disclose selecting the software programs for a personal computer includes the step of identifying the function of the user. www.patents. ibm.com disclose in selecting the software programs for a personal computer includes the step of identifying the function of the user. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select the software programs which are needed for that personal computer in the step of identifying the function of the user. This is because it would improve Christer's system to identify the user's job function.

As per claim 15, Christer disclose in a software module for selection of the selected software including to input the user's function and to select software for addition or deletion programs from a listing of programs which are appropriate for that user. See PP 1, 5-6.

7.   Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of WWW.patents.ibm.com as applied to claim 12 above, and further in view of Harding, 5794052.

As per claim 13, Christer disclose in a personal computer system initially loaded with software including selected See fig 1, Pages 4-6. However, he fails to disclose in a software which erases non-selected software from the personal computer. Harding discloses in a software which erases non-selected software from the personal computer. See col 3, lines 32-37, col 8, lines 3-9. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will erase non-selected software. This is because it would improve Christer's system to remove unnecessary software so it can have enough and fast memory to run or execute programs in a PC.

8.   Claim 16, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of Thomas, 4685055, Fink et al, 5953533 and www.patents. ibm.com.

As per claim 16, Christer disclose in a personal computer system initially loaded with software including selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form. He also disclose in storing the converted software programs in usable form into the storage of the personal computer.

See fig 1, Pages 4-6. However, he fails specifically to disclose selecting the software programs which are needed for that personal computer. www.patents. ibm.com disclose selecting the software programs which are needed for that personal computer. See Page 1. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select the software programs which are needed for that personal computer. He also fails to disclose in paying royalties on only the selected software. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment. Fink et al, 5953533 discloses in selected programs stored in the storage device in usable form aft er conversion from unusable form selected programs having been converted by the processor from unusable form and stored in usable form, see fig 1, col 3, lines 53-67 -- col 4, lines 1-33, col 7, lines 21-31, with non-selected programs not being converted into usable form. See col 4, lines 1-5. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will load non-selected software. This is because it would improve Christer's system to have a software in unusable form.

As per claim 18, Christer disclose in the step of selecting the subset of programs includes a user input which serves to add to or delete from the list of programs based on user preferences. See PP 1, 5-6.

As per claim 19, Christer disclose in the step of selecting the subset of programs includes a user input which serves to add to or delete from the list of programs based on user preferences. See PP 1, 5-6. However, he fails specifically to disclose in the appropriate royalties can be paid. Official notice is taken that paying appropriate royalties is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include paying royalties because this would improve Christer's system to have better payment method.

As per claim 20, a personal computer system initially loaded with software including selected and non-selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form, with non-selected programs not being converted into usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in paying royalties for a plurality of personal computers so that a single royalties can be paid for a plurality of personal computers. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment.

As per claim 21, Christer disclose in preparing a list of the software for each computer along with a list of the user and the functional organization for each personal computer. See PP 1, 3-6.

9.	Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of WWW.patents.ibm.com and Fink et al, 5953533 as applied to claim 16 above, and further in view of Harding, 5794052.

As per claim 17, Christer disclose in a personal computer system initially loaded with software including selected See fig 1, Pages 4-6. However, he fails to disclose in a software which erases non-selected software from the personal computer. Harding discloses in a software which erases non-selected software from the personal computer. See col 3, lines 32-37, col 8, lines 3-9. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will erase non-selected software. This is because it would improve Christer's system to remove unnecessary software so it can have enough and fast memory to run or execute programs in a PC.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Nakashima et al, US Patent 5,875,247, August 01, 1995. System for decrypting encrypted software.

B. Edwards US Patent 6,289,512, December 03, 1998. Automatic Program Installation.

C. Utsumi et al, US Patent 5,809,300, March 12, 1993. Removable storage medium and computer system using the same.

D. Luu US Patent 5,860,012, Jan 12, 1999. Installation of application software through a network from a source computer system on to a target computer system.

E. Gupta US Patent 5,887,164, Mar. 23, 1999. System and method for enabling a target computer to use storage resources of a host computer.

F. Elledge US Patent 6,367,073, Apr 02, 2002. Centralized, automated installation of software products.

G. Dickey, US Patent 5,881,236, Mar. 09, 1999. System for installation of software on a remote computer system over a network using checksums and password protection.

H. Nabahi, US Patent 6,006,035, Dec. 21, 1999. Method and system for custom computer software installation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mussie Tesfamariam** whose telephone number is **(703)305-1393**. The examiner can normally be reached on Monday - Friday from 8:00 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the **examiner's supervisor, Eric Stamber** can be reached at **(703) 305-8469**.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or **faxed to:**

(703)872-9326, (for formal communications intended for entry, before final)

Or:

(703)872-9327, (for after - final)

Or:

(703) 872-9325, (for customer service)

Or:

(703) 746-5546 (for informal communication to send to the Examiner)

Hand-delivered responses should be brought to **Crystal park V, 2451 Crystal Drive**

Arlington, Virginia, (Receptionist).

Mussie Tesfamariam

July 25, 2002

STEPHEN GRAVINI
PRIMARY EXAMINER